67. (New) The computer-based system of claim 53, wherein the occurrence of the negative indicator is relevant to predicting a predefined outcome for the applicant.

68. (New) The computer-based system of claim 53, wherein the stem question response cannot be altered by the applicant after completion of the question collection.

Remarks

Claims 1-46 are pending in the present application as of the mailing of the Office Action. Applicant appreciates the courtesies extended to Applicant's counsel during a telephone interview with the Examiners on June 4, 2003.

The Office Action states that the application contains two distinct inventions. Invention I includes Claims 1-17, 25-35, 37, 43, 45, and 46. Invention II includes Claims 18-24, 36, 38-42, and 44. As discussed with Examiner Bleck on February 20, 2003, Applicant elects to prosecute the claims of Invention I, which is directed to a method and computer readable medium for acquiring life history information for an applicant for employment. As subsequently discussed with the Examiner on June 4, 2003, Claim 16 should properly be included with the claims of Invention II; therefore, Claim 16 is cancelled. Additionally, Applicant herein adds new claims 47-68 directed to the elements of Applicant's computer readable medium, method, and computer-based system.

The Examiner objects to the Abstract of the Disclosure because it exceeds 150 words. Submitted herewith as a separate paper is a corrected Abstract.

Claims 1-2, 6-15, 17, and 25-31 stand rejected. The Examiner has rejected claims 17 and 25-31 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 17, and 25-31 are amended herein to overcome the Examiner's rejection.

The Examiner has also rejected Claims 1-2, 6-15, 17, and 25-31 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,551,880 to Bonnstetter et al. in view of U.S. Patent No. 5,893,098 to Peters et al. and a publication by Sarchione et al.

The Examiner's Rejections Under 35 U.S.C. 103(a) Should Be Withdrawn

The CAFC (and the CCPA before it) have repeatedly held that, absent a teaching or suggestion in the primary reference for the need, arbitrary modifying of a primary reference or combining of references is improper. The ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577. 221 USPQ 929, 933 (Fed. Cir. 1984). In re Gieger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

Claims 1-2, 6-15, 17, and 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,551,880 to Bonnstetter et al. in view of U.S. Patent No. 5,893,098 to Peters et al. and a publication by Sarchione et al.

Independent Claims 1 and 15, as amended herein, clarify that an applicant for employment is presented a collection of questions related to life history information, the life history information comprising more than one life event. Further, Claims 1 and 15, as amended, require that the response to the stem question and the response to the hidden branch question are relevant to predicting a predefined negative outcome for the applicant, e.g., failure to complete training, receipt of a formal disciplinary action, etc.

The Prior Art Teaches Away From Applicant's Invention

Bonnstetter discloses a system that uses measured *behavioral and value characteristics* of an individual to predict employment success, not a predefined negative outcome using *life history information comprising more than one event.* Indeed, Bonnstetter actually teaches away from the present invention. Specifically, Bonnstetter teaches that information regarding prior experience, training, and education, i.e., life history information are "not generally conducive to a highly accurate prediction rate for matching an employee with a particular job". (Column 1, Lines 26-31). The Examiner repeatedly, and accurately, cites the system of Bonnstetter as increasing the accuracy of a prediction for an individual's success for a particular job. This is the opposite of present invention, which acquires life history information that is relevant to predicting a predefined negative outcome, or event, e.g., failure to complete training, etc. Applicant submits that the term "event" should be given its plain meaning, since Applicant has not otherwise given the term a special meaning. That is, "event" is defined as: 1.a. Something that takes place; an occurrence; b. A significant occurrence or happening; 2. The final result; the outcome. *The American Heritage College Dictionary* 475 (3d. ed. 1997). Indeed, the word "event" is never used by Bonnstetter. Likewise, the words "outcome" and "occurrence" are never used. The Examiner also acknowledges that Bonnstetter fails to disclose using questions related to life history information, but improperly equates the life history information used by the present invention to behavioral and value characteristics used in the system of Bonnstetter.

The Examiner relies upon Peters et al., which discloses a method of obtaining and collating information from users by asking survey questions having branched components.

Peters et al. only collects and collates the responses. Peters et al. has nothing to do with acquiring information for use in making employment decisions and, thus, is simply not relevant to the present invention. The Examiner has not articulated how or why Bonnstetter and Peters et al. can be combined. In short, it cannot be done. Rather, as Peters et al. teaches, and as the Examiner has acknowledged, Peters et al. is directed to a system and method for reducing the amount of time to answer a survey by displaying only questions that are relevant to the user, reducing the amount of information received from the user, thus reducing the cost and amount of storage needed for the responses. These are neither the elements, nor the objectives, of Applicant's invention. Further, Peters et al. does not disclose obtaining information to predict outcome, failure or success. Rather, Peters et al. only collects and collates the responses.

The Sarchione et al. reference, co-authored by one of the inventors of the present invention, discloses a process for predicting dysfunctional job behaviors among law enforcement officers. Information is obtained through personal history questionnaires, a structured interview, and/or a background investigation. Sarchione et al., however, does not disclose a computer-based system or the use of stem and branch questions, the responses to which are relevant to predicting predefined negative employment outcome. Again, Sarchione et al. is not properly combinable with Bonnstetter because, as the Examiner correctly states, Bonnstetter is directed toward acquiring information used to predict employment success, whereas Sarchione et al. is directed to acquiring information to predict a predefined negative outcome.

Conclusion

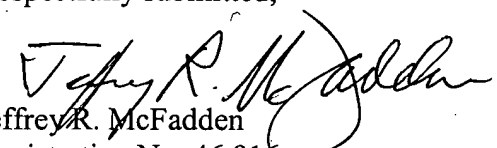
Applicant believes that this case is now in condition for an immediate allowance with Claims 1 –15, 17, 25-32, and 53-68, and such action is respectfully requested. If any issue

remains unresolved, Applicant's counsel would appreciate the opportunity for a telephone interview to expedite allowance.

If it has not yet been done, please change the mailing address for all correspondence in this case as follows:

Womble Carlyle Sandridge & Rice, PLLC
300 N. Greene Street, Suite 1900
Greensboro, North Carolina 27401

Respectfully submitted,



Jeffrey R. McFadden
Registration No. 46,916
Lewis S. Rowell
Registration No. 45,469
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC
300 N. Greene Street, Suite 1900
Greensboro, NC 27401
(336) 574-8060

Date: June 27, 2003
File No.: 4590-004 (4.5)

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please cancel claims 3-5, 16, 18-24 and 32-46. Please add new claims 47-68.

Please amend the following claims to read as follows:

1. (Amended) A computer based method for acquiring life history information from an applicant for employment to minimize positive response bias and enhance the veracity of the acquired life history information, comprised of:

presenting to the applicant a collection of questions related to [at least one life event] life history information, the life history information comprising more than one life event, the question collection being comprised of a revealed stem question and at least one hidden branch question, the hidden branch question being related to the stem question;

receiving from the applicant a response to the stem question and storing the stem question response in a computer database;

based on the stem question response, automatically determining whether to present the at least one hidden branch question to the applicant; [and]

if the at least one hidden branch question is to be presented to the applicant, revealing the branch question to the applicant, receiving from the applicant a response to the branch question and storing the branch question response in the computer database[.]; and

wherein the response to the stem question and the response to the hidden branch question are relevant to predicting a predefined negative outcome for the applicant.

branch question and storing the branch question response in the computer database[.]; and

a4 Contd

wherein the response to the stem question and the response to the hidden branch question are relevant to predicting a predefined negative outcome for the applicant.

a5

17. (Amended) The computer readable medium [method] of claim 15, wherein the negative indicator is a critical item.

25. (Amended) The computer readable medium [method] of claim 15, wherein the applicant is an applicant for law enforcement, criminal justice or public safety employment.

26. (Amended) The computer-readable medium [method] of claim 15, wherein the predefined outcome is an objective outcome.

a6

27. (Amended) The computer readable medium [method] of claim 15, wherein the predefined outcome is a negative outcome.

28. (Amended) The computer readable medium [method] of claim 15 [26], wherein the predefined negative outcome is an objective outcome.

29. (Amended) The computer readable medium [method] of claim 28 [27], wherein the predefined objective, negative outcome is the applicant's failure to complete training.

a2

10. (Amended) The method of claim 1, wherein the response to the at least one stem question is comprised of descriptive information.

12. (Amended) The method of claim 11[10], wherein the negative indicator is a critical item.

a3

13. (Amended) The method of claim 12[10], wherein the occurrence of the negative indicator is relevant to predicting the [a] predefined negative outcome for the applicant.

15. (Amended) A computer readable medium comprising software for acquiring life history information from an applicant for employment to minimize positive response bias and enhance the veracity of the acquired life history information, wherein the software instructs a computer to:

present to the applicant a collection of questions related to [at least one life event] life history information, the life history information comprising more than one life event, the question collection being comprised of a revealed stem question and at least one hidden branch question, the hidden branch question being related to the stem question;

a4

receive from the applicant a response to the stem question and storing the stem question response in a computer database;

based on the stem question response, automatically determine whether to present the at least one hidden branch question to the applicant; [and]

if the at least one hidden branch question is to be presented to the applicant, reveal the branch question to the applicant, receiving from the applicant a response to the

30. (Amended) The computer readable medium [method] of claim 28 [26], wherein the predefined objective, negative outcome is the applicant's receipt of a predefined disciplinary action.

31. (Amended) The computer readable medium [method] of claim 28 [26], wherein the predefined objective, negative outcome is notification of a performance deficiency.

Please add the following claims:

47. (New) The computer readable medium of claim 15, wherein the response to the at least one stem question is comprised of descriptive information.

48. (New) The computer readable medium of claim 15, wherein the response to the at least one hidden branch question is relevant to at least one negative indicator.

49. (New) The computer readable medium of claim 49, wherein the negative indicator is a critical item.

50. (New) The computer readable medium of claim 50, wherein the occurrence of the negative indicator is relevant to predicting a predefined outcome for the applicant.

51. (New) The computer readable medium of claim 15, wherein the stem question response cannot be altered by the applicant after completion of the question collection.

52 (New) A computer-based system for acquiring life history information from an applicant for employment to minimize positive response bias and enhance the veracity of the acquired life history information, comprising:

a user interface for:

presenting to the applicant a collection of questions related to life history information, the life history information comprising more than one life event, the question collection being comprised of a revealed stem question and at least one hidden branch question, the hidden branch question being related to the stem question;

receiving from the applicant a response to the stem question and storing the stem question response in a computer database;

a computer processor that:

automatically determines whether to present the at least one hidden branch question to the applicant based on the stem question response;

if the at least one hidden branch question is to be presented to the applicant, reveals the branch question to the applicant, receiving from the applicant a response to the branch question and storing the branch question response in the computer database; and

wherein the response to the stem question and the response to the hidden branch question are relevant to predicting a predefined negative outcome for the applicant.

A7 Cont'd

53 (New) The computer-based system of claim 53, wherein the negative indicator is a critical item.

54. (New) The computer-based system of claim 53, wherein the applicant is an applicant for law enforcement, criminal justice or public safety employment.

55. (New) The computer-based system of claim 53 wherein the predefined outcome is an objective outcome.

56. (New) The computer-based system of claim wherein the predefined outcome is a negative outcome.

57 Cont'd

58. (New) The computer-based system of claim 57, wherein the predefined negative outcome is an objective outcome.

58. (New) The computer-based system of claim 58, wherein the predefined objective, negative outcome is the applicant's failure to complete training.

59. (New) The computer-based system of claim 58, wherein the predefined objective, negative outcome is the applicant's receipt of a predefined disciplinary action.

60 (New) The computer-based system of claim 58, wherein the predefined objective, negative outcome is notification of a performance deficiency.

61. (New) The computer-based system of claim 53 wherein the predefined negative

outcome is selected from the group consisting of an employment event, a criminal event and a substance event.

60. (New) The computer-based system of claim 53, wherein the response to the at least one stem question is comprised of descriptive information.

61. (New) The computer-based system of claim 53, wherein the response to the at least one hidden branch question is relevant to at least one negative indicator.

A7 Cont'd

62. (New) The computer-based system of claim 53, wherein the negative indicator is a critical item.

63. (New) The computer-based system of claim 53, wherein the occurrence of the negative indicator is relevant to predicting a predefined outcome for the applicant.

64. (New) The computer-based system of claim 53, wherein the stem question response cannot be altered by the applicant after completion of the question collection.